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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,077	01/03/2002	Mikio Ihama	Q67609	2227

7590

05/28/2003

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Washington, DC 20037-3213

EXAMINER

LETSCHER, GERALDINE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 05/28/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/034,077

Applicant(s)

IHAMA ET AL.

Examiner

Geraldine V Letscher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1-3-02 & 1-22-03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Morimoto (U.S. Patent No. 6,544,725).

Morimoto discloses a silver halide photographic emulsion embodied by the instant claims (column 20, line 12+; column 61, line 45+), said emulsion comprising silver iodochlorobromide tabular grains each having (111) faces as main planes, wherein at least 70% of the total grain projected area comprises grains having the following characteristics:

- (a) hexagonal tabular grains, in each of which a ratio of a length of an edge with a maximum length to a length of an edge with a minimum length is 2 or less (column 20, line 14);
- (b) at least one apex position of the hexagon has an epitaxial junction portion having a silver chloride content between 5 and 25 mol% (column 22, line 44);
- (c) the silver chloride content is between 0.5 and 6 mol% (column 21, line 44); and
- (d) the silver iodide content is between 0.5 and 10 mol% (column 21, line 48).

The applied reference has a common assignee with the instant application.

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Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

3. Claims 1-20 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/955,437 to Ihama et al. which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application 09/955,437. In fact, this application has been allowed and will issue shortly.

Ihama et al. discloses a silver halide photographic emulsion embodied by the instant claims, said emulsion comprising silver iodochlorobromide tabular grains each having (111) faces as main planes, wherein at least 70% of the total grain projected area comprises grains having the following characteristics:

- (a) hexagonal tabular grains, in each of which a ratio of a length of an edge with a maximum length to a length of an edge with a minimum length is 2 or less;
- (b) at least one apex position of the hexagon has an epitaxial junction portion having a silver chloride content between 5 and 25 mol%;

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(c) the silver chloride content is between 0.5 and 6 mol%; and

(d) the silver iodide content is between 0.5 and 10 mol%.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

4. Claims 1-20 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/778,874 to Ihama which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application 09/778,874. In fact, this application has been allowed and will issue shortly.

Ihama discloses a silver halide photographic emulsion embodied by the instant claims, said emulsion comprising silver iodochlorobromide tabular grains each having (111) faces as main planes, wherein at least 70% of the total grain projected area comprises grains having the following characteristics:

(a) hexagonal tabular grains, in each of which a ratio of a length of an edge with a

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maximum length to a length of an edge with a minimum length is 2 or less;

(b) at least one apex position of the hexagon has an epitaxial junction portion having a silver chloride content between 5 and 25 mol%;

(c) the silver chloride content is between 0.5 and 6 mol%; and

(d) the silver iodide content is between 0.5 and 10 mol%.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

5. Claims 1-20 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/955,438 to Ihama which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application 09/955,438. In fact, this application has been allowed and will issue shortly.

Ihama discloses a silver halide photographic emulsion embodied by the instant claims, said emulsion comprising silver iodochlorobromide tabular grains each having

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(111) faces as main planes, wherein at least 70% of the total grain projected area comprises grains having the following characteristics:

- (a) hexagonal tabular grains, in each of which a ratio of a length of an edge with a maximum length to a length of an edge with a minimum length is 2 or less;
- (b) at least one apex position of the hexagon has an epitaxial junction portion having a silver chloride content between 5 and 25 mol%;
- (c) the silver chloride content is between 0.5 and 6 mol%; and
- (d) the silver iodide content is between 0.5 and 10 mol%.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

### ***Double Patenting***

6. Claims 1-20 of this application conflict with claims of Application No. 09,778,874. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the

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conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/778,874. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a silver halide photographic emulsion embodied by the instant claims, said emulsion comprising silver iodochlorobromide tabular grains each having (111) faces as main planes, wherein at least 70% of the total grain projected area comprises grains having the following characteristics:

- (a) hexagonal tabular grains, in each of which a ratio of a length of an edge with a maximum length to a length of an edge with a minimum length is 2 or less ;
- (b) at least one apex position of the hexagon has an epitaxial junction portion having a silver chloride content between 5 and 25 mol%;



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(c) the silver chloride content is between 0.5 and 6 mol%; and

(d) the silver iodide content is between 0.5 and 10 mol%.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

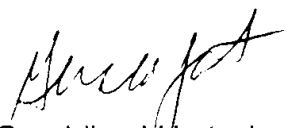
**Priority**

8. The following prior art made of record and not relied upon is considered pertinent to applicants' disclosure: U.S. Patent No. 6,432,626; U.S. Patent No. 5,496,694.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V Letscher whose telephone number is 703-308-3208. The examiner can normally be reached on usually Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Geraldine V. Letscher  
Primary Examiner  
Art Unit 1752

May 27, 2003